

REMARKS

This is in response to the Office Action mailed May 16, 2005 in relation to the above-identified patent application. In that office action, the Examiner asserts that the Applicant's claimed apparatus (claims 1-7) "can be used in various [materially different] ways," and thus Applicant's claimed apparatus and method of use are distinct under MPEP § 806.05 (h). The Examiner further asserts the search required for Applicant's apparatus (Group I) is not required for Applicant's method (Group II).

Pursuant to 37 CFR § 1.143, Group I is hereby provisionally elected with traverse. Additionally, Applicant has amended Independent Claim 1 to include the limitation "shaft for striking the ball..." and has amended Dependent Claim 6 to make it more readable. Applicant now asserts that his method claims 8-12 are not "independent and distinct" from his apparatus claims 1-7. All of the limitations found in the apparatus claims 1-7 (i.e., striking, storing, scooping, and tossing ball) are further expanded upon in the applicant's method of use claims 8-12, thereby precluding any "materially different" use of the apparatus.

The Examiner correctly states the applicable rule for determining restrictions found in MPEP Section 806.05 (h). This section states that a process is distinct from the product if 1) the process for using the product as claimed can be practiced with another materially different product, or 2) the product as claimed can be used in a materially different process of using that product (see MPEP Section 806.05 (h)). However, the provision further states an examiner must provide an example of that alternative use or process. In the office action, the Examiner states that "the apparatus as claimed can be used in various ways," but provides no example of an alternative use. Further, in compliance with MPEP § 806.05 (h), the "various ways" in which the Applicant's claimed apparatus may be used must be "materially different." Due to the shape the

Applicant's claimed apparatus (golf club like), any alternative uses are limited to golf and golf-like games and processes. Independent Claims 1 and 4 now clearly describe a golf club like apparatus used for striking an elastomeric ball. This language would not be considered materially different from any type of golf or related game. Moreover, both the Applicant's claimed method and apparatus are found in the same class (473); thus, implying the absence of a material difference.

PTO Commissioner Tegtmeyer noted "unity of invention" is not destroyed where the apparatus as claimed can be practiced by another method so long as both processes are not materially different. 22 U.S.P.Q. (BNA) 77. Even if the Applicant's apparatus as claimed may be used in various ways, none of these are "materially different." Accordingly, Applicant respectfully submits the restriction requirement has been successfully traversed.

CONCLUSION

Applicant respectfully requests a reconsideration of the restriction requirement in light of the claim amendment and arguments herein.

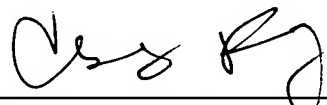
If the Examiner feels for any reason that direct contact with Applicant's attorney will advance the prosecution of this case to finality, the Examiner is invited to contact the undersigned.

No additional filing fee is due.

Respectfully submitted,

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